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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------|------------------|
| 09/978,607   | 10/15/2001  | William L. Hecht     | 0112300/959               | 5117             |
| 29159  | 7590        | 05/04/2004           | EXAMINER                  |                  |
| BELL, BOYD & LLOYD LLC<br>P. O. BOX 1135<br>CHICAGO, IL 60690-1135 |             |                      | CHERUBIN, YVESTE GILBERTE |                  |
|  |             |                      | ART UNIT                  | PAPER NUMBER     |
|  |             |                      | 3713                      |                  |

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/978,607             | HECHT ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Yveste G. Cherubin     | 3713                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7-13,15,16,18-20,22,24,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-13,15,16,18-20,22,24,26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/23/2004</u>   | 6) <input type="checkbox"/> Other: _____                                    |

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1. This action is in response to the Amendment filed February 6, 2004. Claims 6, 14, 17, 21, 23, 25 have been cancelled, claim 27 added. Thus, claims 1-5, 7-13, 15-16, 18-20, 22, 24, 26-27 are pending.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites the limitation "...the step of repeating steps (b) through (d)...." in lines 1-

2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-13, 15-16, 18-29, 22, 24, 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukahara (US Patent No. 6,416,411-of record).

Regarding claims 1, 9, 10, 11, 12-13, 15, 19, 24, 26, Tsukahara discloses an apparatus and method of use of a gaming device comprising a wager game. Tsukahara's device

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further comprises at least one data storage device, 2:17-18, at least one sound file (melody) stored in the data storage, 2:17-18, at least one variant sound file stored in the data storage device, the variant sound file being a variation of the sound file (melody) wherein the variation between the sound file (melody) and the variant sound file is a change in tempo, 2:39-41; at least one player input event (winning event) stored in the data storage device, the player input event associated with the variant sound file, 7:39-47, 59-67, 8:40+; at least one speaker (21) at least one player input device (17a-17c) 8:32-33; and a processor (24) in communication with the data storage device, the player input device (17a-17c) and the speaker (21), which (a) plays the sound file (melody) after a predetermined event occurs; (b) plays the variant sound file after the player uses the player input event associated with said variant sound file to occur, 8:40+; and (c) stops playing the sound file at a predetermined point in time after the player causes said player input event to occur, 8:40+. As shown Tsukahara discloses a musical gaming device comprising sound effects which may comprise a fanfare (melody), 2:36 and wherein the plurality of sound effect patterns may comprise an identical (same) melody which differs from each other in at least one of tempo and interval thereof, 2:40-43. Tsukahara discloses using random generator to output the sound effects. Although Tsukahara fails to disclose the first sound file being played being a primary sound file, one of ordinary skill in the art would note that any sound file being played first would be considered as the primary or first sound file and any sound file subsequently played would be a variant of the primary sound file, 2:40-43. Accordingly, including a primary sound file in the Tsukahara device would be obvious.

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Regarding claim 2, Tsukahara discloses including at least one game event stored in the data storage device, 5:7-28, 7:63+.

Regarding claim 3, Tsukahara discloses the predetermined event being the game event, 5:7-28.

Regarding claim 4, Tsukahara discloses including a plurality of player input events stored in the data storage device, 7:63-67, 8:1-7.

Regarding claim 5, Tsukahara discloses the predetermined event including one of a plurality of player input events, 5:7-25, 6:63-67.

Regarding claim 7, Tsukahara discloses the predetermined event being initiation of a predetermined game mode, 5:12-29, 7:29-46.

Regarding claim 8, Tsukahara discloses the game mode being a winning mode being read as a hand pay mode, 5:12-29, 8:40-46.

Regarding claim 16, Tsukahara discloses a method of providing sound change in a gaming device, said method comprising the steps of initiating a predetermined game mode, 8:33-39, 9:36-41 playing a musical sound recording, 9:36-41, receiving a player input from a player, 8:40-43, and changing a musical variable in said musical sound recording, wherein the step of changing the musical variable includes a changing tempo, 2:35-57, 9:42-48. As per continuing to play the change musical sound until predetermined event occurs, it would have been obvious to one of ordinary skill in the art to set up the system as such in order to avoid confusion and provide game events associated with sound files.

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Regarding claim 18, Tsukahara discloses the recited limitations as stated above. Repeating the steps would have been an obvious matter of design choice.

Regarding claims 20, 22, Tsuhara discloses the claimed invention as substantially as discussed above. Tsukahara further discloses a plurality of player inputs (17a-17c), plurality of musical recordings or sound files, 2:19-20, 9:36-42.

Regarding claim 27, it recites the limitations of claims 1 and 8 combined, therefore refer to claims 1 and 8 above for rejection.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-5, 7-13, 15-16, 18-20, 22, 24, 26-27 have been considered but are moot in view of the new ground(s) of rejection.

### ***Final Rejection***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Conclusion**


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yveste G. Cherubin whose telephone number is (703) 306-3027. The examiner can normally be reached on 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, T. Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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